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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,637	12/19/2005	Yoshimichi Kawai	52433/831	2907

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ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

GILBERT, WILLIAM V

ART UNIT	PAPER NUMBER
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3635

MAIL DATE	DELIVERY MODE
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08/20/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,637	Applicant(s) KAWAI ET AL.	
	Examiner WILLIAM V. GILBERT	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>21 June 2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a first action following a request for continued examination.

- Claims 1-3 are cancelled.
- Claims 4-6 are pending and examined.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 21 June 2010 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Odell (U.S. Patent No. 2,291,498) in view of Bailey (U.S. Publication 2003/0145537) and Howell (U.S. Patent No. 4,869,040).

Claim 4: Odell discloses a construction of a wall opening (see Fig. 6, "D" below) in a house comprising:
a first side face wall frame member ("A" from attached Fig. 6, below) laterally spaced from a second side face wall frame member (the side opposite "A" below; not shown in the drawing but would be present);
an opening upper frame member ("E") disposed between said first side face wall frame member and said second side face wall

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member;

an opening lower frame member ("F") located below said opening upper frame member, said opening lower frame member disposed between said first side face wall frame member and said second side face wall frame member (as shown);

said first side face wall frame member, said second side face wall frame member, said opening upper frame member, and said opening lower frame member defining said wall opening (as shown);

said first side face wall frame member having an inner vertical longitudinal frame member ("G") located adjacent the side wall opening, said inner vertical longitudinal frame member having an upper end and a lower end;

said first side face wall frame member having an outer vertical longitudinal frame member (would be behind portion "J"; see Figure 2 which shows that frame members are placed at the edges of panel members) with an upper transverse frame member (would be behind portion "K" below) disposed between said upper end of said inner vertical longitudinal frame member and said outer vertical longitudinal frame member and a lower transverse frame member (would be behind portion "L" below) disposed between said lower end of said inner vertical longitudinal frame member and said outer vertical longitudinal frame member;

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said second side face wall frame member having an inner vertical longitudinal frame member (equivalent to portion "G" on the opposite side) located adjacent said wall opening, said inner vertical longitudinal frame member having an upper end and a lower end;

said second side face wall frame member having an outer vertical longitudinal frame member ("M") with an upper transverse frame member ("N") disposed between said upper end of said inner vertical longitudinal frame member and said outer vertical longitudinal frame member and a lower transverse frame member ("O") disposed between said lower end of said inner vertical longitudinal frame member and said outer vertical longitudinal frame member;

a first side face wall (proximate "A") fixed to said first side face wall frame member;

a second side face wall (a second member 14) which would be fixed to said second side face wall frame member;

a vertical wall panel ("B") having a lower end fixed to said opening upper frame member and said first and said second side face upper frame members;

a wainscot wall panel ("C") having an upper end fixed to said opening lower frame member and said first and said second side face lower frame members;

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said vertical wall panel integrated with an upper end of said first and said second side face walls; and
said wainscot wall panel integrated with a lower end of said first and said second face walls.

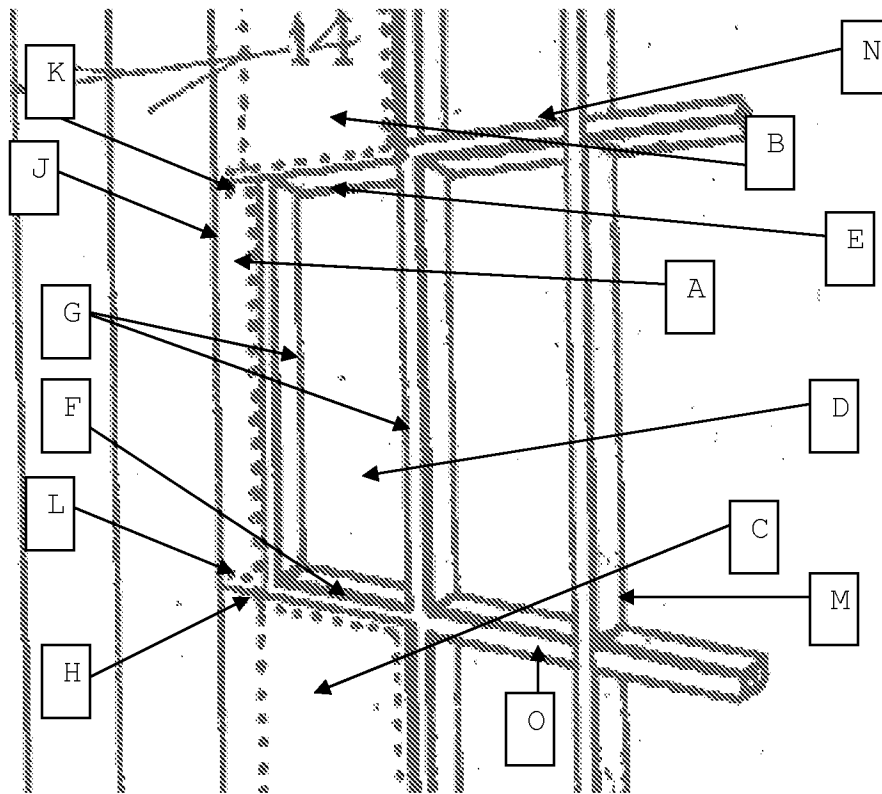
Odell does not disclose the upper and lower frame members (applicant's 154 and 157) as claimed. Bailey discloses that it is known in the art to place such members in framing systems (see Fig. 15: 1 and proximate 19). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have the frame members as shown in Bailey with the system in Odell because having members placed in this manner insures adequate strength for a frame system. Further, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have this limitation because optimizing will not support patentability of subject matter encompassed by the prior art unless there is evidence indicating such a limitation is critical. See M.P.E.P. §2144.05 "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454 (CCPA 1955) (Claimed process which was performed at a temperature between 40C and 80C and an acid concentration between 25% and 70% was held to be *prima facie*

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obvious over a reference process which differed from the claims only in that the reference process was performed at a temperature of 100C and an acid concentration 10%.) In addition, the examiner takes Official notice to connect the members as claimed with metal joints, such as nails (equating to applicant's 81), as these are well known in the art for connecting such members.

Last, Odell does not disclose that the system is made of steel, though Howell discloses a steel framing system used for construction (Col. 2, lines 20-25). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use a steel system as disclosed in Howell because it is well known in the art to use steel framing due to its strength and durability and longer life over a wood counterpart.

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**Figure 6 from Odell**

Claim 5: The obvious combination of the prior art of record discloses a construction of a wall opening in a steel house according to claim 4, wherein said upper transverse frame members of said first side face wall frame member and said second side face wall frame member are integrated with said opening upper frame member and said first side face wall has an upper end connected to said upper transverse frame member of said first side face wall frame member and said second side face wall has an upper end connected to said upper transverse frame

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member of said second side face wall frame member.

Claim 6: The obvious combination of the prior art of record discloses a construction of a wall opening in a steel house according to claim 4, wherein said lower transverse frame members of said first side face wall frame member and said second side face wall frame member are integrated with said opening lower frame member and said first side face wall has a lower end connected to said lower transverse frame member of said first side face wall frame member and said second side face wall has a lower end connected to said lower transverse frame member of second side face wall frame member.

Response to Arguments

3. The following addresses applicant's remarks/arguments dated 21 June 2010:

Applicant's remarks are considered moot based on the new grounds of rejection as applicant amended the claims. The examiner maintains the prior art still meets the claimed limitations as provided above and maintains the arguments as previously presented. While noting applicant is arguing differences in the claimed invention and the prior art, during

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patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim....” (*Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1968 (Fed. Cir. 2004)).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM V. GILBERT whose telephone number is (571)272-9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William V Gilbert/
Examiner, Art Unit 3635